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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENT MASSEY

Appeal 2009-007025¹
Application 10/003,196
Technology Center 2400

Decided: January 29, 2010

Before KENNETH W. HAIRSTON, JOHN C. MARTIN, and
CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

WHITEHEAD, JR., *Administrative Patent Judge*.

DECISION ON APPEAL

¹ We refer to Appellant's Amended Brief filed April 7, 2008.

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-4, 6-18, 20-22, and 24-33. *See* Br. 3. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We affirm-in-part.

STATEMENT OF THE CASE

Appellant invented an application employing alternative and variation scenes from which an appropriate scene from the set is selected and interspersed into a scene sequence to adapt the scene sequence in response to interactive decisions made by the viewer.²

Claims 1 and 9, which further illustrate the invention, follow:

1. A method for structuring scene sequences for interactive entertainment, the method comprising the steps of:
 - (a) providing a plurality of potentially viewable scenes to deliver an overall storyline to a viewer;
 - (b) delivering some of the scenes to the viewer as branching points at which alternative decisions are presented that will determine the next scene sequence to be presented to the viewer;
 - (c) for each alternative decision at a branching point, having available to present to the viewer a scene sequence corresponding to the decision;
 - (d) enabling the viewer to select one of the alternative decisions;
 - (e) in response to the viewer's selected one of the alternative decisions, presenting the scene sequence that corresponds to the decision;
 - (f) structuring the branching points and their related scene sequences such that essentially every set of scene sequences determined by viewer decisions eventually reaches at least one linking scene containing content that is not dependant upon the particular decisions made prior to the linking scene;
 - (g) producing one or more sets of variation scenes that introduce content that reflects the consequences of previous decisions selected from among the alternative decisions presented prior to the linking scene, each set of

² See generally Br. 3-9.

variation scenes being associated with a scene that is viewable after the linking scene; and

(h) when the viewer is brought to a scene sequence that contains a set of variation scenes, interspersing into the scene sequence the variation scene corresponding to the viewer's selected one of the alternative decisions from among the alternative decisions presented prior to the linking scene.

9. An interactive entertainment embodied in a digital video storage medium with a data structure readable by a digital video player, and having an overall storyline to be delivered to a viewer, said data structure comprising:

(a) a plurality of potentially viewable scenes;

(b) some of the scenes defining branching points of the entertainment by presenting alternative decisions from which the viewer selects one of the alternative decisions;

(c) for each alternative decision at a branching point, a sequence of scenes corresponding to the decision;

(d) the branching points and their related scene sequences being structured such that essentially every set of scene sequences determined by viewer decisions eventually reaches at least one linking scene containing content that is not dependant upon the particular decisions made prior to the linking scene;

(e) one or more sets of variation scenes that introduce content that reflects the consequences of previous decisions selected from among the alternative decisions presented prior to the linking scene and that corresponds to the viewer's selected one of the alternative decisions, each set of variation scenes being associated with a scene sequence that is viewable after the linking scene, and

(f) software-enabled coding for interspersing in a scene sequence a variation scene that is selected from a set of variation scenes associated with that scene sequence, wherein the selection is based upon previous decisions made prior to the linking scene.

*The Rejections*³

The Examiner relies upon the following prior art references as evidence of unpatentability:

Bejan	US 5,465,384	Nov. 7, 1995
Shiels	US 5,754,770	May 19, 1998
Abecassis	US 6,553,178 B2	Apr. 22, 2003

Claims 9-18, 20-22, and 24-31 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter (Ans. 3-5).

Claims 1-4, 6-10, 18, 20-22, 24, 27, 30, and 31 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Bejan (Ans. 5-13).

Claims 18, 20-22, 27-29, and 31-33 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Shiels (Ans. 14-17).

Claims 11, 13, 14, 16, 17, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bejan and Shiels (Ans. 17-21).

Claims 12 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bejan and Abecassis (Ans. 20-21).

Rather than repeat the arguments of Appellant or the Examiner, we refer to the Brief and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellant. Arguments which Appellant could have made but did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008).

³ Claim 34 has been cancelled by Appellant (App. Br. 1). A rejection of claim 1 for nonstatutory obviousness-type double patenting has been withdrawn by Examiner (Ans. 2).

35 U.S.C. § 101 as being directed to non-statutory subject matter

The Examiner argues that independent claims 9, 18, 24, and 27 all contain non-statutory subject matter (Ans. 3-5). The Examiner further argues that each of the before mentioned claims contains non-functional descriptive material that “*in the absence of a functional interrelationship with a computer, does not constitute a statutory process, machine, manufacture or composition of matter and is thus non-statutory per se.*” *Id.* (emphasis added).

ISSUE

Has Appellant shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 101 because the claims contain non-functional descriptive material that, absent a functional interrelationship with a computer, does not constitute a statutory process?

FINDINGS OF FACT

1. Appellant’s Specification describes storing scenes on a compact disc (CD) or any suitable digital video storage medium as a DVD, computer hard drive, broadcast file, or server file (Spec. ¶ [00037]).
2. Appellant’s Specification further describes that the medium for storing, delivering, or presenting the interactive entertainment is not limited to any particular type of medium (Spec. ¶ [00071]).

PRINCIPLES OF LAW

Computer-related non-statutory subject matter

Despite the apparent sweep of 35 U.S.C. § 101, the Supreme Court

has held that certain categories of subject matter are not entitled to patent protection. *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972). In the most recent majority opinion addressing § 101, the Supreme Court explained that there are three categories of subject matter for which one may not obtain patent protection. These judicially-created exceptions are “laws of nature, natural phenomena, and abstract ideas.” *Diamond v. Diehr*, 450 U.S. 175, 185 (1981). The Federal Circuit has further recognized that the Court's precedent suggests “the ‘mathematical algorithm’ exception [an example of the abstract idea judicial exception] applies to true apparatus claims.” *In re Alappat*, 33 F.3d 1526, 1542 (Fed. Cir. 1994). Thus, the mathematical exception analysis used in “*Benson* . . . applies equally whether an invention is claimed as an apparatus or process, because the form of the claim is often an exercise in drafting.” *Id.* (quoting *In re Johnson*, 589 F.2d 1070, 1077 (CCPA 1978) (internal quotation marks omitted)).

“‘[F]unctional descriptive material’ consists of data structures and *computer programs* which impart functionality when employed as a computer component.” MANUAL OF PATENT EXAMINING PROCEDURE § 2106.01 (rev. 6, Sept. 2007) (“MPEP”) (emphasis added). Functional and non-functional descriptive material, however, are both nonstatutory when claimed as descriptive material per se. *Id.*; see also *In re Warmerdam*, 33 F.3d 1354, 1360 (Fed. Cir. 1994).

If the Examiner’s burden to establish a prima facie case of unpatentability is met, the burden then shifts to Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative

persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ANALYSIS

Claims 9-18 and 20-22

The Examiner cites the preamble of claim 9 (“*[a]n interactive entertainment embodied in a digital video, storage medium with a data structure readable by a digital video player, and having an overall storyline to be delivered to a viewer, said data structure*”) for having a data structure which does not impart functionality to a computer or computing device and therefore is non-statutory per se (Ans. 3-4) (emphasis added). Appellant states that the Examiner’s position is erroneous because the claimed interactive entertainment includes a data structure in the form of potentially viewable scenes with rules pertaining to particular scene variation in the form of software-enabled coding (Br. 12). Appellant further argues that the claimed data structure imparts functionality to a digital video player and therefore is functional statutory subject matter. *Id.*

Claim 9 discloses functional descriptive material (*data structure*) recorded on a computer readable medium (*digital video storage medium*) that, when employed as a computer component, imparts functionality to a digital video player. Although claim 9 discloses a data structure, Appellant has shown that the Examiner erred in rejecting independent claim 9 as well dependent claims 10-17 under 35 U.S.C. §101 because the data structure is recorded on a readable medium and imparts functionality to a computer component. *See* FF 1-2.

The Examiner cites the preamble of claim 18 (“*[a]n interactive entertainment embodied in a digital video, storage medium with a data structure readable by a digital video player, and having an overall storyline to be delivered to a viewer, said data structure*”) for having a data structure which does not impart functionality to a computer or computing device and therefore is non-statutory per se (Ans. 4) (emphasis added). Appellant argues that the claimed data structure imparts functionality to a digital video player and therefore is functional statutory subject matter (Br. 12-13).

Claim 18 discloses functional descriptive material (*data structure*) recorded on a computer readable medium (*storage medium*) that, when employed as a computer component, imparts functionality to a *digital video player*. Although claim 18 discloses a data structure, Appellant has shown that the Examiner erred in rejecting independent claim 18 as well dependent claims 20-22 under 35 U.S.C. §101 because the data structure is recorded on a readable medium and imparts functionality to a computer component. *See* FF 1-2.

Claims 24-29

The Examiner cites the preamble of claims 24 and 27 (“*[a]n interactive entertainment embodied in an electronic format with a readable data structure and having an overall storyline to be transmitted to a viewer over a communications network*”) for having a data structure which does not impart functionality to a computer or computing device and therefore is non-statutory per se (Ans. 4) (emphasis added). Appellant argues that the claimed data structure imparts a functionality to the transmission over the network and therefore is functional statutory subject matter (Br. 13).

Claims 24 and 27 disclose functional descriptive material (*data structure*); however, there is no indication that the material is recorded on a computer readable medium or that the material imparts functionality to a computer component. Appellant has not shown that the Examiner erred in rejecting independent claims 24 and 27 as well as dependent claims 25, 26, 28 and 29 under 35 U.S.C. §101 because the data structure is not recorded on a readable medium and fails to impart functionality to a computer component.

Claims 30 and 31

The Examiner cites the preamble of claims 30 and 31 (“[a]n *interactive entertainment embodied in an electronic format with a readable data structure and having an overall storyline to be transmitted to a viewer over a broadcast network*”) for having a data structure which does not impart functionality to a computer or computing device and therefore is non-statutory per se (Ans. 4-5) (emphasis added). Appellant argues that the claimed data structure imparts a functionality to the transmission over the broadcast network and therefore is functional statutory subject matter (Br. 14-15).

Claims 30 and 31 disclose functional descriptive material (*data structure*), however there is no indication that the material is recorded on a computer readable medium or that the material imparts functionality to a computer component. Appellant has not shown that the Examiner erred in rejecting independent claims 30 and 31 as well as dependent claim 33 under 35 U.S.C. §101 because the data structure is not recorded on a readable medium and fails to impart functionality to a computer component.

Anticipation rejection over Bejan

Claim 1

Appellant readily admits that steps (a) through (f) of the method disclosed in claim 1 are prior art (Br. 18). Appellant argues that Bejan fails to disclose the novel claimed steps (g) and (h). *Id.* Appellant further argues that claim 1 requires in step (g) the production of sets of *variation scenes* that can be used to alter the content of scene sequences that may be viewed after passing a linking point and in step (h) that the *variation scene* corresponding to the viewer's decisions presented prior to the linking scene is interspersed into the scene sequence (Br. 19).

ISSUES

Has Appellant shown that the Examiner erred by finding that Bejan produces variation scenes that can be used to alter the content of scene sequences that may be viewed after passing a linking point and that Bejan discloses interspersing into the scene sequence variation scenes corresponding to the viewer's decisions presented prior to the linking scene?

Has Appellant shown that the Examiner erred by finding that Bejan discloses that the viewer's alternative decisions determine the order of subsequent acts?

FINDINGS OF FACT

3. Figure 3 of Bejan is reproduced below:

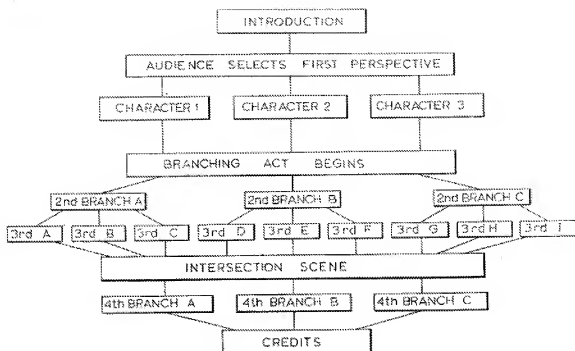


FIG. 3

Figure 3 discloses a flowchart illustrating the series of images which may be shown during an episode utilizing the interactive entertainment system.

4. Bejan discloses that it is only the perspective which is changed by the audience's choice of character and not the plot or series of events (col. 7, ll. 34-38). Bejan further discloses that since the plot continues at the same pace for all three characters, the audience can change which characters are displayed without upsetting the chronological story (col. 7 ll. 38-45).
5. Bejan discloses using portions of scenes that can be used in more than one scene in order to preserve storage space (col. 10, ll. 12-21).

PRINCIPLES OF LAW

“For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single

reference.”” *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990) (quoting *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677 (Fed. Cir. 1988)). “These elements must be arranged as in the claim under review,” *id.* at 832 (citing *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984)), but this is not an “ipsissimis verbis” test, *id.* at 832-33 (citing *Akzo N.V. v. U.S. Int’l Trade Comm’n*, 808 F.2d 1471, 1479 & n.11 (Fed. Cir. 1986)).

ANALYSIS

Appellant argues that the Examiner’s reliance upon Bejan’s last decision in the multi-perspective scene to associate the character with the remainder of the viewed episode does not address Bejan’s deficiency in regard to failing to disclose steps (g) and (h) of claim 1 (Br. 19-20). The Examiner disagrees with Appellant for several reasons: (1) Bejan discloses that the first decision associated with a character is made prior to the intersection scene and that decision is reflected throughout the show for each selected branch even after the 4th branch after the linking scene (i.e., the intersection scene); and (2) Bejan discloses a scene sequence (i.e., 4th Branch A, 4th Branch B, and 4th Branch C) with variation that corresponds to alternative decisions based upon the decisions made by a viewer prior to the intersection or linking scene (Ans. 27). We do not find Appellant’s arguments to be persuasive in light of the teachings of Bejan. We therefore sustain the Examiner’s rejection of claim 1.

As the Examiner has indicated, Bejan discloses producing one or more sets of variation scenes that are reflective of consequences presented prior to the linking scene. *See* FF 3. This is readily evident in Figure 3 of

Bejan, wherein there is a variation of scenes (i.e., 4th branch scenes) present in the system after the linking scene (Bejan's intersection scene) that reflects the consequences of previous decisions made within the character stage. *Id.* Further, Bejan discloses interspersing portions of scenes within various other scenes (FF 4).

Claims 2 and 3

Appellant argues that Bejan fails to disclose “*producing the variation scenes in a set with essentially the same characters and props, such that the variation scenes in a set differ from each other by the dialog and expression of at least one character*” (Br. 20). Appellant supports his position by arguing that the claimed step allows the scene sequence to have a primary content by re-shooting a few exchanges between the characters as a set of variation scenes (*id.*). The Examiner argues that the claims do not include re-shooting and that Bejan discloses producing variation scenes as disclosed in claim 2. *See* Ans. 28. We agree with the Examiner that Appellant's “re-shooting” argument is not commensurate with the scope of the claim and that Bejan discloses producing the claimed variation scenes. *See* FF 3. Claim 2 is therefore not distinguishable over Bejan. Appellant does not separately argue with particularity the limitations of claim 3. We therefore sustain the Examiner's rejection of claims 2 and 3 for the reasons indicated previously.

Claims 4 and 6

Independent claim 4 recites, *inter alia*, “*presenting to the viewer alternative decisions that will determine an order in which at [sic] a subsequent act will be presented*” (emphasis added).

Appellant argues that Bejan does not allow acts to be viewed in different order based upon viewer selection and highlights steps (b) and (c) of claim 4 (Br. 21). According to Appellant, Figure 3 shows a single order of acts that is unaffected by viewer selections: Introduction→Branching Act→Intersection Scene→Credits (Br. 22). The Examiner argues that Bejan discloses the capability of altering the order of the acts when the viewer selects a character that leads to particular storyline or action branch (Ans. 29). We agree with the Appellant. Bejan discloses that the viewer selection does not interfere with the order of the subsequent acts (FF 4). Therefore we will not sustain the Examiner’s rejection of claim 4.

Appellant further argues that claim 6 add steps to the invention of claim 4 (Br. 23). Appellant relies upon claim 4’s asserted patentability over Bejan for the patentability of claim 6. *See id.* We did not find the Examiner’s arguments to be persuasive in regard to claim 4 and therefore we will not sustain the Examiner’s rejection of claim, 6 which depends upon claim 4.

Claims 7 and 8

Independent claim 7 similarly recites “*presenting to the viewer alternative decisions that will determine an order in which a subsequent act will be presented*” (emphasis added). Appellant argues that the viewer in Bejan does not have a way of interchanging the order of acts, for example,

presenting the Intersection Scene before the Branching Act because Figure 3 of Bejan does not disclose that acts can be presented in a different order based upon viewer's selection (Br. 23). Bejan discloses that the viewer selection does not interfere with the order of the subsequent acts (FF 4). Therefore we find the Appellant's argument to be persuasive and we will not sustain the Examiner's rejection of claim 7.

Appellant further argues that claim 8 adds steps to the invention of claim 7 (Br. 24). Appellant relies upon claim 7's asserted patentability over Bejan for the patentability of claim 8. *See id.* We did not sustain the Examiner's rejection of claim 7 and therefore we will not sustain the Examiner's rejection of claim 8, which depends upon claim 7.

Claims 9 and 10

Appellant states that independent claim 9 has structural limitations that relate to the method steps of claim 1 (Br. 25). Appellant further argues that the Examiner made the same error as he did in rejecting claim 1 over Bejan. *Id.* We did not find that the Examiner erred in rejecting claim 1 over Bejan and, for the same reasons as previously given in regard to claim 1, we will sustain the Examiner's rejection of claim 9.

Appellant also argues that claim 10 has structural elements similar to the method of claim 4. *See* Br. 26. Appellant relies upon claim 9's asserted patentability over Bejan for the patentability of claim 10 and therefore chose not to argue the merits of claim 10 separately. *See id.* We did not find claim 9 to be patentable over Bejan; therefore, we will sustain the Examiner's rejection of claim 10, which depends upon claim 9.

Claims 18 and 20-22

Appellant argues that independent claim 18 has structural elements similar to the method steps of claim 4 (Br. 26). Appellant further argues that, just as with claim 4, Bejan does not allow acts to be viewed in different order based upon viewer selection. *Id.* We found the Appellant's argument to be persuasive when it was presented in regard to claim 4 and we find it persuasive in regard to claim 18 for the reasons stated previously. The rejection of claim 18 is not sustained.

Appellant further argues that dependent claim 20 includes the digital video storage having means for enabling the viewer to make the alternative decisions (Br. 27). Appellant relies upon claim 18's asserted patentability over Bejan for the patentability of claims 20-22. *See id.* We did not sustain the Examiner's rejection of claim 18 and therefore we will not sustain the Examiner's rejection of claims 20-22, which depend upon claim 18.

Claim 24

Appellant argues that Bejan discloses elements (a) to (d) but fails to disclose elements (e) and (f) of independent claim 24. *Id.* Appellant argues that the Examiner made a mistake in treating Bejan's re-usable scene portions to be the variation scenes recited in element (e), because the content of those re-usable scenes does not reflect the consequences of previous decisions, as required by claim 24. (Br. 28). We agree. However, this argument by Appellant fails to address the Examiner's alternative finding that Bejan's 4th branch scenes (after Bejan's intersection scene) reflect the consequences of previous decisions made within the character stage (Ans.

10). We agreed with that finding for reasons we stated previously in the discussion of claim 1.

Further, Appellant's argument that Bejan does not disclose element (f) is not persuasive because the Examiner has shown that Bejan discloses software-enabled coding (*see* Ans. 33; FF 5) and the Examiner's findings on this limitation were not addressed by Appellant.

Therefore, we will sustain the Examiner's rejection of claim 24.

Claims 27-29

Independent claim 27 recites "*alternative decisions that will determine an order in which a subsequent act will be presented*" (emphasis added). Appellant argues that Bejan fails to disclose elements (b), (c), and (d) of claim 27 (Br. 28). The Examiner argues that Appellant made similar arguments in regard to claim 7 with the exception of software-enabled coding, which was added by element (d) of claim 27 (Ans. 33). Therefore, we do not find the Examiner's arguments persuasive for the reasons we stated previously in regard to claims 7 and 24. We will not sustain the Examiner's rejection of independent claim 27 as well as dependent claims 28 and 29.

Claim 30

Appellant argues that Bejan fails to disclose elements (e) and (f) of claim 30 (Br. 29-30). In claim 30, element (e) involves variation scenes that introduce content that reflects the consequences of previous decisions selected from among the alternative decisions presented prior to the linking scene and element (f) involves software-enabled coding. We have addressed

both of these elements in regard to Bejan previously and Appellant does argue or present anything new that we have not considered; therefore, we do not find Appellant's arguments persuasive for the reasons that we stated previously. We will sustain the Examiner's rejection of claim 30.

Claim 31

Appellant argues that Bejan fails to disclose elements (b), (c), and (d) of claim 31 (Br. 30-31). In claim 31, element (b) involves alternative decisions from which the viewer can select, element (c) involves presenting the scenes in different order and element (d) involves software-enabled coding. We have addressed these elements in regard to Bejan previously and the Examiner does argue or present anything new with respect to this claim that we have not previously considered. Therefore, we do not find Examiner's arguments persuasive for the reasons that we stated previously. We will not sustain the Examiner's rejection of claim 31.

Anticipation rejection over Shiels

Claims 18 and 20-22

Appellant argues that Shiels's structure does not allow the viewer to decide to change the order in which the act is viewed (Br. 31). Appellant relies upon Figure 6 of Shiels to support his position that Shiels discloses a branching narrative that only allows the viewer to move from the beginning A towards the narrative ends W, X, Y, or Z. *Id.*

ISSUES

Has Appellant shown that the Examiner erred by indicating that Shields discloses allowing the viewer to change the order in which one or more acts are viewed?

Has Appellant shown that the Examiner erred by finding that Shields discloses an alternative scene having content dependent upon the order in which an act is viewed?

FINDINGS OF FACT

6. Figure 6 of Shields is reproduced below:

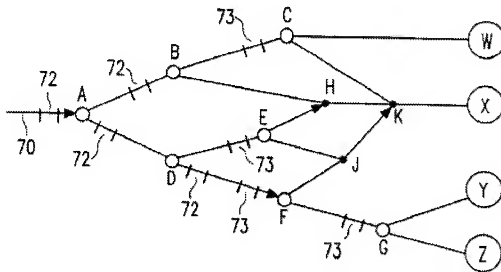


FIG. 6

Figure 6 discloses an arrangement of a branch narrative structure.

7. Shields discloses that in order to control the number of possible endings, some paths combine (for example, at nodes H, J and K) such that some sections of the narrative (for example, H to K) may appear within the

narrative regardless of which path is chosen at node A in Figure 6 (col. 6, ll. 9-16).

8. Shiels discloses that a principle requirement for seamlessly joining video sequences is to have sufficient time to call up the next segment and synchronize its start to the end of the present sequence. Shiels achieves this by utilizing interaction periods (72, 73). Each branch of the narrative has a default setting that will continue along the default path if no user input occurs during the interaction periods (col. 6, ll. 23-49).

9. Shiels discloses a method for providing episodic interactive entertainment (col. 8, ll. 13-15).

ANALYSIS

Appellant argues that Shiels does not allow the viewer to decide to change the order in which an act is viewed and that the Examiner has failed to indicate any place in the Shiels reference where a viewer can decide to reverse the order of acts (Br. 31). Appellant further argues that “[t]he viewer is unable to take an act that is viewed enroute to any point in the chosen path and chose to view it after that point instead of enroute to the point.” (*Id.*) The Examiner responds by finding that Shiels discloses that the acts are presented in different order with four possible endings (Ans. 36) and that “Shiels discloses that segments can be reached in different order as claimed. For instance path 1 in Figure 6 can include nodes A, B, and H (H being the third node), whereas path 2 can include nodes A, D, E, and H (H being the fourth node). *See also* FF 6. Further, the Examiner argues that the claims do not explicitly require that the alternative connecting scenes of the acts are

placed out of order for selection by the viewer (Ans. 36). We agree with the Examiner.

Appellant's arguments are not commensurate with the scope of the claim. Claim 18 does not require that the order can be reversed. Claim 18 only requires that the viewer has *at least one set of alternative decisions* from which the *viewer selects one of the alternative decisions that will determine an order* in which a subsequent act will follow. As the Examiner has indicated, Shiels discloses the claimed determination of the order of the acts. Appellant's attempt to distinguish the claim over the Shiels reference by arguing that the Examiner improperly interprets the term *path* to mean *order* is not persuasive. *See* Br. 32. The claim language does not preclude the recited "different order" from being based on a comparison of two different paths. The term "different order" in claim 18 is not as narrow as Appellant contends.

Appellant also argues that

while scenes H, J and K of Shiels can be reached by different decision paths, they do not contain sets of alternative scenes in which the content is dependant even upon the path taken to arrive there, much less upon the order in which the acts are viewed. There is no act in Shiels with this capability.

(Br. 33.)

Claim 18 recites that "*each act that can be presented in a different order having neutral scenes in which the content is not dependant upon the relative order*" and Shiels discloses this feature (for example, scenes H, J, and K). *See* FF 6-7. Claim 18 further recites "*sets of alternative scenes in which the content is dependent upon the relative order in which the act is viewed.*" We agree with Appellant that Shiels fails to disclose this feature

because none of the scenes depicted in Figure 6 has content that is dependent upon the order in which the scene is viewed.

Regarding the Examiner's reliance on the "flashback" scenes, Appellant argues that "Shiels' ability to grab a scene sequence after viewing it, and then recall it by choice at some later time as a memory 'flashback', is not the same or similar to providing sets of alternative scenes that can be inserted into an act to add content that is appropriate to the order in which the act is viewed." (Br. 33.) We understand Appellant to mean that the flashback scenes do not have content dependent upon the relative order in which the act is viewed." We agree with Appellant.

Therefore we will not sustain the Examiner's rejection of claim 18 or rejection of dependent claims 20-22.

Claims 27-29

Appellant argues that element (b) of claim 27 demonstrates why Shiels's entertainment structure does not allow the viewer's decision to change the order in which the act is viewed (Br. 34). In addition, Appellant argues that Shiels is devoid of decision points and therefore, once a decision is made as to which act to view next, the other acts are eliminated from being chosen downstream. *Id.*

These arguments are not commensurate with the scope of the claim. The claim only requires at least one set of alternative decisions from which the viewer selects and, once the alternative decision has been selected, the order of the subsequent act is determined. The alleged elimination of some of Shiels's other acts after the decision is made would not affect the viewer's ability to select one alternative decision from the set. If Shiels's other acts

are eliminated, as Appellant argues, the claim would still read on the reference because the decision would still be made, as required by the claim.

Appellant also argues that Shields fails to disclose elements (c) and (d) because Shields does not disclose any means for presenting neutral scenes interspersed with alternative scenes that are “appropriate to the relative order of the act presentation” (Br. 34-35). We understand this argument to be based on claim 27’s recitation of “alternative scenes in which the content is dependant upon the relative order in which the act is viewed.” The Examiner found that Shields discloses neutral scenes presented with alternative scenes that are appropriate to the relative order, such as H, J, or K (Fig. 6), which can appear no matter which path is taken (Ans. 37). *See also* FF 6. We agree with Appellant that none of the scenes depicted in Figure 6 has content dependent on the order in which the act is viewed. We will not sustain the Examiner’s rejection of claim 27 or dependent claims 28 and 29.

Claim 31

Appellant argues that the limitations or elements of claim 31 are similar or identical to the elements of claim 27 and that the same analysis presented for claim 27 applies. We will not sustain the Examiner’s rejection of claim 31 for the same reasons as stated previously.

Claims 32 and 33

Appellant argues that Shields does not disclose a method for providing interactive entertainment in episodic format wherein the viewer’s decisions determine the order in which subsequent episodes will be presented (Br. 35-36). The Examiner found that Shields discloses a method for providing

interactive entertainment in episodic format (Ans. 38-39, citing Shiels, col. 8, ll. 12-19). *See also* FF 9. We do not find Appellant's arguments in regard to the episodic limitations or elements of the claims to be persuasive. Appellant argues, with the exception of the type of periodic format, subject matter that we have previously addressed, such as the impact of the viewer's decision on the order of subsequent scenes, acts, or episodes. The term "order" in the claim does not preclude the claim from being read on different paths. We will sustain the Examiner's rejection of independent claim 32 as well as dependent claim 33 for the same reasons previously stated.

Obviousness rejection over Bejan and Shiels

Claims 11, 13, 14, 16, and 17

Appellant argues that dependent claims 11, 13, 14, 16, and 17 are patentable because the teachings of claims 9 and 10 are not disclosed by either Bejan or Shiels or a combination thereof (Br. 37-38). We have sustained the rejections of claims 9 and 10 and therefore we will sustain the Examiner's rejections of claims 11, 13, 14, 16, and 17 for the same reasons as stated previously.

Claims 25 and 26

Appellant argues that dependent claims 25 and 26 are patentable because they depend upon claim 24 and Bejan fails to disclose or suggest elements (e) and (f) of claim 24 (Br. 38-39). We have sustained the rejection of claims 24 and therefore we will sustain the Examiner's rejections of claims 25 and 26 for the same reasons as stated previously.

Obviousness rejection over Bejan and Abecassis

Claims 12 and 15

Appellant argues that dependent claims 12 and 15 are patentable because the teachings of claims 9 and 10 are not disclosed by Bejan (Br. 39-40). We have sustained the rejections of claims 9 and 10 and therefore we will sustain the Examiner's rejection of claims 12 and 15 for the same reasons as stated previously.

CONCLUSIONS

Appellant has shown that the Examiner erred in rejecting claims 9-18 and 20-22 under 35 U.S.C. § 101.

Appellant has not shown that the Examiner erred in rejecting claims 24-31 under 35 U.S.C. § 101.

Appellant has not shown that the Examiner erred in finding that Bejan produces variation scenes that can be used to alter the content of scene sequences that may be viewed after passing a linking point and that Bejan discloses interspersing into the scene sequence variation scenes corresponding to the viewer's decisions presented prior to a linking point.

Appellant has shown that the Examiner erred in finding that Bejan discloses that the viewer's alternative decisions determine the order of subsequent acts.

Appellant has not shown that the Examiner erred in finding that Shiels discloses allowing the viewer to change the order in which one or more acts are viewed.

Appellant has shown that the Examiner erred by finding that Shiels discloses an alternative scene having content dependent upon the order in which an act is viewed.

ORDER

We will sustain at least one of the Examiner's rejections of each of claims 1-3, 9-17, and 24-33. We will not sustain any rejection of claims 4, 6-8, 18, and 20-22.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

babc

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